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|-----------------|-------------|----------------------|---------------------|------------------|
| 09/412,178      | 10/05/1999  | JOSEPH M. CANNON     | 82-75-30            | 9308             |

7590 03/29/2004

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EXAMINER

TIEU, BINH KIEN

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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2643

DATE MAILED: 03/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/412,178

Applicant(s)

CANNON ET AL.

Examiner

BINH K. TIEU

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

**DETAILED ACTION**

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-8 and 10-20 are rejected under 35 U.S.C. 102(b) as being anticipated by Schull et al. (U.S. Pat. #: 5,521,964).

Regarding claim 1, Schull et al. ("Schull") teaches a method of providing a visual message waiting indicator signal to an off-hook telephone, comprising the steps of:

receiving a voice message at a central location; and

sending a visual message waiting indicator signal from the central location and destined for the off-hook telephone (col.9, lines 18-54 wherein the indicator 3C is defined in col.3, lines 65-67).

Regarding claims 2-6, note col.5, line 66 – col.8, line 60.

Regarding claim 7, Schull teaches a method of providing a visual message waiting indicator signal to an off-hook telephone, comprising the steps of:

being in an off-hook condition; and

receiving a visual message waiting indicator signal (col.9, lines 18-54 wherein the indicator 3C is defined in col.3, lines 65-67).

Regarding claim 8, note col.7, lines 44-50 and col.9, lines 48-54.

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Regarding claims 10-12, note col.5, line 66 – col.8, line 60.

Regarding claim 13, Schull teaches a telephone (i.e., customer 3, fig.1), comprising:  
a visual message waiting indicator (i.e., indicator 3C); and  
an interface unit (i.e., VMWI 3B) adapted to couple the telephone to a network, such that the telephone is in an off-hook condition when couple to the network and engaged in a communication facility, and is in an on-hook condition when coupled to the network and not engaged in a communication facility (col.3, lines 59-67; col.5, line 66 – col.6, line 5; col.6, lines 28-38),

wherein the interface unit is adapted to receive a visual message waiting indicator signal when in the off-hook condition (col.9, lines 18-54 wherein the indicator 3C is defined in col.3, lines 65-67).

Regarding claims 14-17, note suppressed ringing connection that inherently muting a transducer at customer location 3, col.5, line 66 – col.8, line 60.

Regarding claim 18, Schull teaches a telephone switch (i.e., Switch 2), comprising:  
a message storage unit (i.e., VMS) adapted to receive a voice mail message associated with a telephone when the telephone is in an off-hook condition; and

a visual message waiting indicator signal transmission unit adapted to transmit a visual message waiting indicator signal to the telephone in the off-hook condition (col.9, lines 18-54 wherein the indicator 3C is defined in col.3, lines 65-67).

Regarding claims 19-20, note col.5, line 66 – col.8, line 60.

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Schull et al. (U.S. Pat. #: 5,521,964) in view of Pietrowicz (U.S. Pat. #: 6,628,779).

Regarding claim 9, Schull teaches all subject matter as claimed above, except for displaying caller ID data associated with a messaging party. However, Pietrowicz teaches such feature in col.7, lines 40-50 for a purpose of saving time for message recipient on reviewing of new incoming messages.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate the use of the feature of displaying caller ID data associated with a messaging party, as taught by Pietrowicz, into view of Schull in order to save time for the message recipient on reviewing of the new incoming message.

***Conclusion***

5. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Although the Schull et al. (US. Pat. #: 5,363,431) is not applied into this Office Action, it is also called to Applicants attention. This references is also concerned with the scope of the claimed inventions cited in claims 1-8 and 9-20.

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6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Binh K. Tieu whose telephone number is (703) 305-3963 and E-mail address: [BINH.TIEU@USPTO.GOV](mailto:BINH.TIEU@USPTO.GOV).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Curtis Kuntz, can be reached on (703) 305-4708 and **IF PAPER HAS BEEN MISSED FROM THIS OFFICIAL ACTION PACKAGE, PLEASE CALL Customer Service at (703) 306-0377 FOR THE SUBSTITUTIONS OR COPIES.**

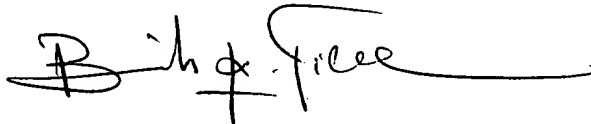
Any response to this action should be mailed to:

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Or faxed to:

(703) 872-9314

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington VA, Sixth Floor (Receptionist, tel. No. 703-305-4700).



**BINH TIEU  
PRIMARY EXAMINER**

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Date: March 21, 2004